

REMARKS

Claims 1-42 are pending in the instant application.

THE REJECTION UNDER 35 U.S.C. § 103 SHOULD BE WITHDRAWN

Claims 1-42 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,074,413 to Davis *et al.* ("Davis") in view of U.S. Patent No. 5,695,520 to Bruckner *et al.* ("Bruckner") for reasons provided in ¶ 3 of the Office Action. More specifically, it is alleged in the Office Action that Davis teaches a wrap for treating back pain "including all the limitations as claimed except for a presence of a rigid nodule as claimed, and that Bruckner discloses "a wrap for treating pain including a nodule as claimed for applying pressure to treat pain."

Based upon these two statements, without more, it is alleged that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ a nodule in view of Bruckner *et al.* into Davis *et al.*'s wrap in order to apply pressure and further treat the pain."

Claims 1-42 are also rejected under 35 U.S.C. § 103(a) as allegedly obvious over Bruckner in view Davis, for the reasons provided in ¶ 4 of the Office Action. More specifically, it is alleged in the Office Action that Bruckner discloses "a wrap for treating pain including a nodule as claimed except for a presence of medicament as claimed," and that Davis teaches "a wrap including medicament as claimed for treating pain (col. 19, lines 1-15)."

Based upon these two statements, without more, it is again alleged that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ medicament in view of Davis *et al.* into Bruckner *et al.*'s wrap in order to further treat pain."

Applicant respectfully traverses and submits that pending claims 1-42 are not obvious over Bruckner, Davis, and the combination thereof.

The legal standard for *prima facie* obviousness requires that three criteria be met: (1) the prior art, either alone or combination, must teach or suggest each and every

limitation; (2) there must be a suggestion or motivation in the cited references or in the art to modify or combine the cited references; and (3) the cited references must provide a reasonable expectation of successfully achieving the claimed invention. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 165 U.S.P.Q. 494, 496 (CCPA 1970).

When carrying out an obviousness analysis, it must be kept in mind that the mere listing of elements or attributes of elements that may be discovered or alleged in the prior art, without more, simply amounts to “hindsight reconstruction ... using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.” (*Grain Processing v. American Maize-Products* 5 USPQ2d 1788, 1792 (Fed. Cir. 1992) (citation and internal quotation omitted)). In fact, in response to such defective analyses, the Court of Appeals for the Federal Circuit has “made it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine the prior art references.” (*In re Dembiczak* 50 USPQ2D 1614, 1617 (Fed. Cir. 1999)).

Specifically, the Court of Appeals for the Federal Circuit has provided that

Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure. (*In re Vaeck* 20 USPQ2d 1438, 1442) (Fed. Cir. 1991) (internal citations omitted)

Moreover, even if it would be possible to modify a prior art reference to arrive at the claimed invention, the art must teach the desirability of that modification. More particularly, if the proposed modification would render the prior art inoperable for its intended purpose, then that art actually teaches away from the proposed modification.

In re Gordon 221 USPQ 1125, 1127 (Fed. Cir. 1984). A rejection is not proper if it is based upon a proposed combination of references that requires a change in the basic principles under which the cited art was designed to operate. *In re Ratti* 123 USPQ 349, 352 (CCPA 1959).

In view of these standards and for the reasons provided below, Applicant respectfully submits that the pending claims are not obvious under § 103 over Davis and Bruckner either alone or in any combination with one another. Applicant respectfully submits that the present rejections reflect use of Applicant's specification as a guide to select various elements allegedly disclosed in Davis and Brucker, which are, in fact directed toward disparate, functionally-exclusive devices.

Applicant respectfully submits that the Examiner has not presented a *prima facie* case of obviousness. That is, neither objective fact nor a convincing line of reasoning have been put forth to support the conclusory statements that it would have been obvious to combine the teaching of Davis and Bruckner in order to arrive at Applicant's claimed invention. More specifically, as noted below, Applicant respectfully submits that the cited art does not fairly teach each and every element of the presently-claimed invention, and that there is no motivation that would lead one of ordinary skill in the art to combine Davis and Bruckner in such a manner as to arrive at Applicant's invention. Finally, even if, solely for the sake of argument, there were some reason for combining the cited art, one of ordinary skill would not have reasonably expected that combination to be successful.

Davis teaches an elastic back wrap that includes thermal packs that, upon exposure to air, generate heat. The thermal back wrap of Davis is applied directly to the specific painful area of the body (*i.e.* directly to the "afflicted body part" col. 2, lines 5-18) that is to be treated by direct application of heat (*also see* col. 19, lines 28-32, and lines 52-55).

In contrast, Bruckner teaches a "pressure-applying device" that is to be disposed on the body in such a manner that pressure is applied to the appropriate acupuncture point to provide relief (*see* col. 1, lines 47-63). For example, nausea is treated by application of the device of Bruckner to the inside of the wrist of the user while headaches are treated by pressure applied by the nodule to a specific point on the back

of the patient's hand (*see e.g.* col. 3, line 65 through col. 4, line 10). Thus one of ordinary skill would understand that the device of Bruckner is not to be applied to the specific, afflicted body part of the patient.

Therefore, when viewed as a whole, one of ordinary skill in the art would understand that Davis and Bruckner teach devices that would be applied to completely different parts of the body for treatment of the same symptom. Based upon the disclosures of Davis and Bruckner, a device combining the heat cells of Davis and the nodule of Bruckner could be used *either* to apply heat to the afflicted body part *or* to apply acupressure to a point on the body physically distant from the afflicted body part, *but not both*. Consequently, there would be no motivation to combine the elements of the thermal wrap of Davis with the pressure-applying device of Bruckner in order to arrive at Applicant's claimed invention. This is so because the Davis thermal wrap and the Bruckner pressure-applying device are based upon completely different principles under they were designed to operate.

One of ordinary skill in the art would realize that, based upon the disclosures of Davis and Bruckner, a combined device would either be inoperable for the intended purpose of Davis or inoperable for the intended purpose of Bruckner. In fact, therefore, the art actually teaches away from the combination proposed by the Examiner (*In re Gordon*). Thus, the present rejections under 35 U.S.C. § 103 based on the combination of Bruckner and Davis are improper and should be withdrawn (*In re Ratti*).

Finally, Applicant submits that the cited art, even in combination, does not fairly teach all of the elements of the presently-claimed invention. In particular, Applicant submits that Davis, taken as a whole, would not suggest to one of ordinary skill, that the elastic thermal back wrap should be further adapted for dispensation of a medicament. That is, Applicant submits that the paragraph noted in the Office Action (col. 19, lines 1-15) (in fact the only such paragraph in the entire patent) merely provides a "laundry list" of materials that might be considered for inclusion in or addition to the disclosed thermal back wrap. There is no suggestion in the cited paragraph, or in Davis as a whole, that would lead one of ordinary skill to incorporate not only a medicament-containing pad but also a substantially-rigid nodule into the thermal back wrap of Davis.

Therefore, Applicant respectfully submits that for the reasons provided above, the rejections under § 103 over the combinations of Bruckner and Davis are improper. Applicant further submits that, for the reasons provided above, even if the combination were proper, there is no motivation for combining the teachings of Bruckner and Davis in an attempt to arrive at Applicant's claimed invention. In fact the difference in the principle under which each disclosed device operates teaches away from the proposed combination and precludes any reasonable expectation that the teachings of Davis and Bruckner could be successfully combined in an attempt to arrive at Applicant's presently-claimed invention.

In summary, Applicant respectfully submits that, for all the reasons provided above, the rejections of pending claims 1-42 as obvious under 35 U.S.C. § 103 over the cited combinations of Davis and Bruckner have been overcome. Accordingly, Applicant respectfully requests that the rejection of claims 1-42 as obvious under 35 U.S.C. § 103, over Davis, be withdrawn.

CONCLUSION

Applicants respectfully requests that the present remarks be entered and made of record in the instant application. An early allowance of the application is earnestly requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

No fee, other than that for the extension of time, is believed to be due for this amendment and response. However, should a fee be due, please charge the required amount to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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